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Paper No. 6
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SALESLOFT, INC.,
Petitioner,

v.

INSIDESALES.COM, INC.,
Patent Owner.

Case IPR2017-01070
Patent 7,072,947 B1

Before WILLIAM V. SAINDON, ROBERT J. WEINSCHENK, and JASON W. MELVIN, *Administrative Patent Judges*.

MELVIN, *Administrative Patent Judge*.

DECISION
Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

Petitioner, SalesLoft, Inc., filed a Petition (Paper 1, "Pet.") requesting *inter partes* review of claims 1–9 and 23–31 of U.S. Patent No. 7,072,947 B1 (Ex. 1001, "the '947 patent"). Patent Owner, InsideSales.com, Inc., did not file a Preliminary Response. Pursuant to 35 U.S.C. § 314 and 37 C.F.R. § 42.4(a), we have authority to determine whether to institute review.

An *inter partes* review may not be instituted unless "the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." 35 U.S.C. § 314(a). For the reasons set forth below, we conclude that there is a reasonable likelihood that Petitioner would prevail in establishing the unpatentability of the challenged claims. We therefore institute *inter partes* review of those claims.

Our conclusions at this stage of the proceeding are preliminary and are based on the evidentiary record developed thus far. This is not a final decision as to the patentability of the claims for which *inter partes* review is instituted. Our final decision will be based on the record as fully developed during trial.

A. RELATED MATTERS

The parties identify the following pending judicial matter as relating to the '947 patent: *InsideSales.com, Inc. v. SalesLoft, Inc.*, Case 2:16-cv-00859 (D. Utah, filed Aug. 4, 2016). Pet. 3; Paper 5, 2.

Additionally, IPR2017-01071 involves a petition for *inter partes* review of U.S. Patent No. 7,076,533, which shares a specification with the '947 patent.

B. THE '947 PATENT

The '947 patent is directed to a "system for monitoring email and website behavior of an email recipient." Ex. 1001, 2:34–35. To that end, it describes a "mail enhancement server . . . configured to intercept all outgoing emails from a mail server" and a "logging server configured to capture and store relevant information relating to the outgoing email." *Id.* at 2:37–39, 3:3–5. "The mail enhancement server modifies each outgoing email to include a tracking code," which may be "embedded within an image call" or part of a hyperlink in the original email that is "modified to include the tracking code." *Id.* at 2:42–48. The '947 patent describes that the functionality of the mail enhancement server may be provided at any point prior to delivery of the email to the recipient, including at the email client used to send the mail. *Id.* at 6:4–20.

When a recipient's computer opens the modified email, the image call or hyperlink causes it to contact the logging server, which may then deliver a cookie to the requesting computer. *Id.* at 2:61–66. The logging server uses the tracking code and cookie to "monitor the activities of the recipient in relation to the email as well as websites visited by the recipient." *Id.* at 3:14–17.

C. CHALLENGED CLAIMS

Challenged claims 1, 9, 23, and 31 are independent. Claim 1 (reproduced below) is illustrative of the claimed subject matter:

> 1. A system for monitoring email behavior of an email recipient, the email recipient being associated with a first email domain, comprising:
>
> control logic configured to modify an outgoing email addressed to the email recipient and sent using an email

client configured to allow a sender to send the outgoing email and access one or more personal or corporate emails belonging to the sender, wherein the control logic configured to modify the outgoing email is further configured to edit the outgoing email to include a tracking code, wherein the tracking code is uniquely associated with the outgoing email, the email recipient, the sender or the business entity associated with the sender or a combination thereof; and

control logic configured to monitor the email behavior of the email recipient With respect to the modified outgoing email;

wherein the monitoring of the email behavior is performed within an Internet domain related to the sender or a business entity associated with the sender;

wherein the first email domain and the Internet domain related to the sender or the business entity associated with the sender are different;

wherein upon the email recipient opening the modified outgoing email, a connection to a remote server is made in which the tracking code is transmitted to the remote server;

wherein the connection to the remote server is an image call inserted into the modified outgoing email;

wherein the tracking code is embedded within the image call; and

wherein upon receipt of the tracking code by the remote server, the remote server is able to determine whether the modified outgoing email has been opened by the email recipient.

Ex. 1001, 13:54–14:21.

D. PROPOSED GROUNDS OF UNPATENTABILITY

Petitioner asserts the following grounds of unpatentability, each based on 35 U.S.C. § 103(a):[1]

References	Challenged Claims
Lessa[2]	1, 2, 5–7, 9, 23, 24, 27–29, and 31
Lessa and Brown[3]	3, 4, 8, 25, 26, and 30

Pet. 15. Petitioner also relies on the Declaration of Dr. Don Turnbull (Ex. 1007).

E. LEGAL PRINCIPLES

1. Obviousness Overview

An invention is not patentable "if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." 35 U.S.C. § 103(a). The question of obviousness is resolved on the basis of underlying factual determinations including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and, (4) where in evidence, so-called secondary considerations, including commercial success, long-felt but

[1] The America Invents Act included revisions to, *inter alia*, 35 U.S.C. § 103 effective on March 16, 2013. Because the '947 patent issued from an application filed before March 16, 2013, the pre-AIA version of 35 U.S.C. § 103 applies.
[2] U.S. Pat. Pub. No. US 2002/0040387 A1 (pub. Apr. 4, 2002).
[3] U.S. Pat. No. 7,584,251 B2 (iss. Sep. 1, 2009).

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